

REMARKS

Claims 1-14 and 16-18 are pending in the application.

Claims 1-2, 5-8, 11-12 and 16 stand rejected under 35 U.S.C. 102(b) as anticipated by Ciotti (US20030051417). Claim 3 stands rejected under 35 U.S.C. 103(a) as unpatentable over Ciotti (US20030051417) in view of Abler (US20060185262). Claim 4 stands rejected under 35 USC 103(a) as unpatentable over Ciotti (US20030051417) in view of Morris (US5966956). Claims 9-10 and 12 stand rejected under 35 U.S.C. 103(a) as unpatentable over Ciotti (US20030051417) in view of WO9802626. Claim 18 stands rejected under 35 U.S.C. 103(a) as unpatentable over Ciotti (US20030051417) in view of Morris (US5966956) and referenced by Fagnoni (US4534141), Howroyd (US4464868), or Mears et al. (US882573).

Applicant would to thank the Examiner for finding that claims 14 and 17 are allowed. This is much appreciated.

I. Rejection under 35 U.S.C. 102(b):

Claims 1-2, 5-8, 11-13 and 16 stand rejected under 35 U.S.C. 102(b) as anticipated by Ciotti (20030051417).

A review of the cited reference indicates that the disclosure therein relates to a construct similar in nature to that presently claimed. However, contrary to the Examiner's conclusion of anticipation, applicant would urge that the reference fails to disclose each and every limitation of the presently rejected claims.

Specifically, Claim 1, on which the remaining claims depend, requires that the claims construct is a:

"container in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity being such that the building construction can be

picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction,"

Simply put, the cited reference neither describes or suggests such structural integrity to be a feature or characteristic of the construct disclosed.

In order for a reference to be anticipatory within the meaning of 35 USC 102, that reference must teach each and every limitation of the claimed invention.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F. 3d 1292, 63 USPQ2d 1597 (Fed.Cir.2002); See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2D 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the....claim. Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the instant case, the reference fails to account for the claim required limitation relating to the structural integrity of the construct. Again, in the instant case, the detail of the claim is set out in the quotation above and there is no equivalent detail in *Ciotti*. In light of this, claim 1 clearly passes the *Richardson* test.

In the last Office Action mailed on April 1, 2009, the Office (through the Examiner) suggested that the *"applicant has not disclosed or identified how the claims provide a structure capable of the claimed structural integrity"*. The Examiner has also suggested that *"the applicant must provide evidence that the claims provide a structure or distinguishing features that the reference does not have"*. With the greatest of respect, we submit that a fundamental flaw in this reasoning is that that it is not, and never has been, the function of the claims of a patent to provide an enabling disclosure of an invention. In order to satisfy 35 USC §102, or in other words, in order to satisfy the requirement for novelty, it is sufficient that a claim sets forth a feature not disclosed in the prior art document. As stated above, *Ciotti* fails to disclose, in as complete detail as is contained in the claim, an arrangement having the feature quoted above. The only evidence required is that the feature is recited in the claim and is not taught by the prior art.

These can both be determined by a reading of the claim and a reading of *Ciotti*.

We appreciate that in the case of seemingly simple inventions, it may be tempting to adopt an essentially intuitive approach to examination. However, we submit that the Courts have, over many years, adopted a structured approach which minimizes the risk of intuitive assessments leading to rejection of inventions which should be seen as qualifying for patent protection. The *Richardson* case cited above is an example of the structured approach helpfully laid down by the courts to assist in assessing claims from a correctly objective, as opposed to an intuitive, perspective. By applying *Richardson* one can readily see that the subject of claim 1 clearly qualifies as novel. That is because there are no instructions in *Ciotti* to produce a structure having the above quoted feature.

In rejecting claim 1 under 35 U.S.C § 102, the Examiner concedes that the *Ciotti* patent does not expressly or impliedly teach the aforementioned claim feature of a structural integrity. (*Office Action*, paragraph 2, page 2). Nonetheless, the Examiner rejects claim 1, contending that the feature of a structural integrity is inherently taught by *Ciotti*. Applicant respectfully traverses this rejection at least because the Examiner has not met its burden to fully develop reasons supporting its reliance on the doctrine of inherency. We point that there is nothing in *Ciotti* which renders the quoted feature "inherent". *Ciotti* is very much a 'top level' or 'generalized' disclosure and omits much detail. That is of course fine in terms of the concept actually claimed in *Ciotti*; however, it does not follow from this that *Ciotti* would be constructed in the manner of Applicant's claim 1. For example, *Ciotti* could be constructed with reliance on temporary posts to give structural integrity or with reliance on some other internal arrangement altogether.

However, more importantly, even if *Ciotti* does rely on swinging walls for some structural integrity it does not follow from that that the degree of integrity is sufficient to withstand the destructive loads that would come into play through (1) crane lifting or (2) stacking beneath a normally loaded freight vehicle. *Ciotti* may show, at figure 2, an arrangement where building units are stacked when in use.

or in other words when erected on site, but there is nothing to explain where the structural integrity for this comes from and, in terms of the stack, there is nothing in *Ciotti* to suggest that the upper units in are loaded as a freight container. It is an issue left unanswered by the somewhat 'top level' disclosure of *Ciotti* and it is likely that the skilled workman would in practice install bracing posts or pillars. It is also likely that the structural integrity for the stack is to a large extent provided by the sideways swinging internal walls 32 shown at figure 11 of *Ciotti*. Our point is that there is nothing in *Ciotti* which makes the quoted feature from claim 1 mandatory or inherent. We very respectfully submit that the rejection is in a sense speculative and not in accordance with the dicta of the *Richardson* case.

In support of the rejection, the examiner has referred to paragraphs 0006 and 0023-0025 of *Ciotti*. These paragraphs simply state that the structure is "dimensioned" to an ISO container size but there is no disclosure at all as to whether the structure has the sort of structural integrity set out in claim 1. The *Ciotti* building may only be constructed with enough strength to be at the top of a stack, not beneath other containers, and to be moved by other than crane lifting. We submit that one can only speculate on that issue and thus there is no disclosure amounting to 'as complete detail as contained in claim 1. Regardless of this, we submit that *Ciotti* still fails to disclose that the relevant structural integrity is derived from the swing out walls and floor.

Applicant would like to bring to the attention of the Examiner that the Office always bears the initial burden to develop reasons supporting a reliance on inherency. (*MPEP* 2112 (IV)). To satisfy this burden, the Office must identify some basis in fact or articulate some reasoning at least tending to show that allegedly inherent subject matter necessarily (i.e., inevitability) flows from cited art. Indeed, the *MPEP* expressly instructs that:

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Further, since a basis in fact and technical reasoning is required when inherency is invoked, a failure to provide such evidence or

rationale is fatal to the reliance on this doctrine. This is only logical since evidence “must make clear” that the allegedly inherent subject matter is necessarily present in (i.e., necessarily flows from) the disclosure of cited art. (*MPEP* 2112).

As mentioned above, a review of the Office Action reveals the absence of the required rationale or evidence at least tending to show that the feature of a structure integrity inevitably flows from the disclosures of *Ciotti* patent. This naked assertion, a mere conclusory statement, cannot reasonably be said to be a development of any reason supporting the Office’s reliance on inherency. Consequently, the Office Action’s reliance on inherency is unsupported and thus improper.

In sum, the Examiner concedes that the *Ciotti* patent does not teach the features of claim 1 as described above and any reliance on the doctrine of inherency to provide this necessary teaching is improper.

We respectfully submit that as claim 1 is novel over *Ciotti* it automatically follows that the dependent claims are novel. This is of course because the novel features of claim 1 flow down to the dependent claims and the anticipation objections to those claims are thus moot.

Therefore, applicant would respectfully request reconsideration and withdrawal of the instant rejection as applied to claims 1-2, 5-8, 11-13 and 16.

II. Rejection under 35 U.S.C. 103(a):

Rejection over Ciotti in view of Abler (20060185262):

At pages 6-7 of the Office action of April 1, 2009, the Examiner has set forth the reasoning in support of the rejection of claim 3 as being unpatentable over the combination of *Ciotti* and *Abler*.

The Examiner acknowledges that *Ciotti* is silence with regard to locking means for the floor and wall portions when they are in a substantially vertical orientation in the

disassembled state. However, the Examiner urges that Abler discloses a similar building construction having hinged wall portions for forming an expanded floor where in a closed position the building is an ISO shipping container, and further discloses that the portions having locking means for freighting.

The Examiner concludes that it would have been obvious to modify the building of Ciotti to have the locking means of Abler to provide a secure container for shipping.

Applicant would initially note, as discussed above relative to the rejection under 35 U.S.C. 102, that neither reference provides that which is missing from the Ciotti reference as to the structural integrity limitation of claim 1 on which claim 3 depends. Applicant would also emphasize the difference in the construct of Ciotti and that of Abler. Clearly the construct of Ciotti includes, in each disclosed construct, multiple portions, beyond a roof and floor as claimed, connected to the individual sides of the center portion of the construct. Abler reasonably appears to disclose a single roof and/or floor portion for each construct or at least each side of the center portion. It appears reasonable that the difference could eliminate the need in the Ciotti construct for a locking mechanism since the multi paneled system itself may provide the basis for keeping the various elements of the construct in place while disassembled. What is clear is that there is no suggestion in Ciotti for a need or advantage to include such a locking mechanism in the construct. Thus, the question becomes why incorporate a limitation or element into the construct if it is not needed. That Abler would suggest such a need does not necessarily carry over to all such constructs and is not clearly applicable to the construct of Ciotti.

For any of these reasons, the aforementioned features of independent claim 1 cannot reasonable be said to be present in the asserted combination.

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103, despite any recent revision to the Manual of Patent Examining Procedure (MPEP). Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render claim 1 unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of the patents to Ciotti and Abler must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Indeed, Applicant submits that this is why Section 904 of the MPEP instructs Examiners to conduct an art search that covers “the invention *as described and claimed*.” (emphasis added). Lastly, Applicant respectfully directs attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int’l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). In sum, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. See *In re Wada and Murphy*, citing

CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Applicant would like to bring to the attention of the Examiner recent changes in the MPEP. The specific changes to section 2143.03 are indicated below:

~~2143.03. All Claim Limitations Must Be Taught or Suggested~~
~~To establish prima facie obviousness of a claimed invention, all the claim~~
~~features must be taught or suggested by the prior art. In re Royka, 490 F.2d 981,~~
~~180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging~~
~~the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382,~~
~~1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious~~
~~under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re~~
~~Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).~~

Again, here, the combination of Ciotti and Abler fail to account for the structural integrity limitation. Further, the prior art does not readily suggest why one would modify the construct of Ciotti with the locking mechanism of Abler when Ciotti does not suggest the need for such locking of the various components.

Thus, applicant would request reconsideration and withdrawal of this ground of rejection.

Rejection over Ciotti in view of Morris (5966956):

At pages 7-8 of the Office action of April 1, 2009, the Examiner sets forth the reasoning in support of the rejection of claim 4 as being unpatentable over the combination of Ciotti, previously discussed, with Morris.

With regard to this ground of rejection, the applicant would again note that Morris fails to provide that which is additionally missing from the Ciotti disclosure. Claim 4 depends on claim 1 and therefore includes the limitation relating to the structural

integrity as discussed above. Neither Ciotti nor Morris disclose or suggest this limitation. As noted in the arguments relative to the previous rejection under 35 U.S.C. 103, the prior art must account for each and every limitation presented in the claim. Since the two references fail to do so, they do not provide an adequate basis for rejecting the claims under 35 U.S.C. 103(a).

Applicant request reconsideration and withdrawal of this rejection.

Rejection over Ciotti in view of WO 9802626:

At pages 8-9 of the Office action of April 1, 2009, the Examiner sets forth the reasoning in support of the rejection of claims 9-10 and 12 as being unpatentable over the combination of Ciotti and the WO 9802626 patent.

While citing Ciotti as previously discussed, the Examiner acknowledges that Ciotti "does not disclose a removable corner protector arranged over at least part of an external edge or along a different external edge of the disassembled construction to provide a measure of protection and/or strength when it is being transported." However, the Examiner cites the WO 9802626 patent as disclosing a foldable, portable building construction comprising removable corner protector 26 to aid in moving the building when being transported. The Examiner concludes that it would have been obvious to modify the construction of Ciotti to include the corner protectors of WO982626 to aid in safely and efficiently transporting the construction, such that the building construction can, when in a disassembled state, be picked up by the crane at or adjacent the four corners of the building construction without causing structural damage thereto.

Applicant would initially note that there is nothing that would suggest the need in the construct of Ciotti for such corner protectors as urged by the Examiner. Further, the

applicant would note that the teaching of the WO9802626 patent actually supports applicant's previous arguments as presented relative to the rejection of claim 1. In applicant's invention the "removable corner protectors" are stated to **protect and add** strength to the structure. (See Spec. page 9, lines 4-6). According to the WO9802626 patent the corner framing described is intended for "use in carrying and facilitating loading and unloading of the container-sized collapsed building" (See page 9, lines 26-33 in discussing connectors 26 of Fig. 16). Clearly, this reasonably suggests that the WO9802626 patent does not provide that which is missing from the disclosure of Ciotti, i.e. a structural integrity which would permit the construct to be moved, stacked and loaded without damage even in the absence of corner framing devices. There is nothing in Ciotti which would suggest the need for additional structure to assist in the moving and loading of the disassembled construct. It remains that the teachings of the two references find structure only when viewed through the teaching and claims of the present invention.

For these reasons, applicant would urge that the combination of Ciotti and the WO9802626 patent do not account for each and every limitation of the claimed invention, since claims 9-10 and 12 depend from claim 1 and do not readily suggest the specific claim limitation of these claims. Applicant requests reconsideration and withdrawal of the present rejection.

Rejection over Ciotti, combined with Morris, and referenced by Fagnoni (US4534141), Howroyd (US4464868) or Mears et al. (US882573)¹:

¹ Applicant would note that it was not possible to identify the Mears reference since it did not correspond to a US patent and was not listed on the PTO-892 included with the Office action. Applicant would note that Kuhn (6772563) which was listed on the PTO-892 but not relied upon includes a disclosure of the type shared by both Fagnoni and Howroyd.

At pages 9-10 of the Office action of April 1, 2009, the Examiner sets forth the support for the rejection of claim 18 as unpatentable over Ciotti taken in view of Morris and referenced by Fagnoni, Howroyd and Mears et al.

The Examiner acknowledges that Ciotti and Morris "do not disclose that the construction is formed such that when the roof portion is swung out to an installed position by way of its pivot connection or connections the roof portion is angled upwards away from the main portion so that parts of the roof portion most remote from the main portion are substantially higher than parts of the roof portion immediately adjacent the main portion, and wherein the position of contact between the adjacent the main portion and wherein the position of contact between the roof portion and the main portion is inherently covered by the roof portion to substantially assist in resisting rain water entering the building construction when the building construction is completely installed."

However, the Examiner cites Fagnoni, Howroyd or Mears as disclosing portable container building constructions with foldable wall extensions where the gap between the main portion and the expandable wall portion is covered to resist rain water from entering the building construction.

Further, the Examiner urges that while the references do not expressly disclose that the roof portions are angled such that the more remote portion is higher than the parts of the roof portion adjacent the main portion, that it is common and well know to have different designed angled roof portions to affect the aesthetic design and interior functionality of a space whether angled up or down.

As to claim 18, applicant would again note the claim limitation that requires that

in the claimed construction the roof portions and the floor portions provide structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction."

Again, the references relied upon by the Examiner simply do not account for this claim limitation as discussed through out this response. Note: In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (See also, MPEP, section 2146.03) (Both previously cited).

As to the Examiner's contention that having the roof portion angled upwards away from the main portion so that parts of the roof portion most remote from the main portion are substantially higher than parts of the roof portion immediately adjacent the main portion" would have been a design feature, applicant would note that no evidence has been submitted for this premise. Further, given the clear concern of the art concerning rain water, applicant would urge that it would not have been obvious to adapt a construction that would serve to actually direct rain water back to the main portion rather than away from it. This is the driving force that makes most construction employ pitched roofs in order to remove or carry water or snow away from the principle structure.

For these reasons, applicant would urge that the present rejection of claim 18 is improperly based, fail to account for all claim limitations and the conclusion of obviousness is not supported by the evidence of record. Applicant would therefore request reconsideration and withdrawal of this rejection.

Conclusion:

Applicant, respectfully, requests reconsideration and withdrawal of these rejections in light of the arguments and discussion presented.

Should any official at the United States Patent and Trademark Office deem that any further action by the Applicant or Applicant's undersigned representative is desirable and/or necessary, the official is invited to telephone the undersigned at the number set forth below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17 or credit any overpayment, to deposit account No. 503321. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, or otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 503321.

Respectfully submitted,

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